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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,888

Applicant(s)

LARSEN, MARTIN WAHLERS

Examiner

HERMAN BELCHER

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-19 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-19 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. This action is in response to amendment filed 06/14/2011.
2. Claims 1-19 are pending.
3. Claims 1-19 are rejected.
4. This Action is a second Non-FINAL.

Response to Amendment

5. Applicants' arguments filed 06/14/2011 regarding the prior art rejection have been fully considered but they are not persuasive.

Applicants' argument:

A. The Applicant argues that "Drumond and Schiavone, individually, or in combination, fail to disclose or suggest...*first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message.... second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages.*"

As to "Item A" and in response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior

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art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the Examiner respectfully disagrees with the Applicant.

Drummond and Schiavone do disclose or suggest the above-mention limitations.

Drummond discloses (col. 2, lines 22-55) where an e-mail is accepted for delivery to e-mail clients only if it from an address (i.e. insignias) that has been verified by an e-mail server, therefore when an e-mail from a particular address is received at the e-mail server for the first time (i.e. first message), the message is delivered to a holding queue instead of being delivered to the intended recipient and the server automatically issues an email to the address to request that the sender verify the authenticity of the original message and if the acknowledgment (i.e. second message) is received within a given time period, the email is deemed acceptable and the email is released from the holding queue and delivered to the intended recipient. However, Drummond does not explicitly disclose prioritizing means (i.e. first or second) for assigning a priority to each of the identification insignias of the senders of the messages (first or second messages)" therefore Schiavone is relied upon to provide this feature.

Schiavone discloses (par. 0034) where incoming message is received by the network appliance and priority information is assigned to message and (par. 0019) where mailers may be prioritized using source address. Schiavone also discloses (par. 0020)

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all e-mail from a given sender (i.e. email address) or domain (i.e. IP address) may be assigned a priority and (0017) where viewable portion of the message, e.g., body, subject line, etc. of the message may be used as the priority information. Since priority information can be assigned when incoming message are received by the network appliance and can be based source address, sender of email or domain, etc, it would have been an advantageous addition to Drummond to include this feature such that the priority information is assign to sender's or source address (i.e. identification insignias) for both the first and second messages since this information could be used to determine how and/or when to deliver the messages (also, see par. 0034).

Therefore, it is evident from the above discussions that Drummond and Schiavone do disclose or suggest and is able to perform the function of the above-mention limitations as recited in claim 1 and similar limitations of independent claims 16 and 17 and if Drummond and Schiavone are capable of performing the intended use, then it meets the limitations of the claim(s).

The Examiner respectfully contends that since the dependent claims depend on the independent claims, the dependent claims remain rejected.

Claim Objections

6. Claims 1, 12, 14 and 17 are objected because the limitations of the claims recite “**second** check means...; **second** prioritizing means”; “**second** means for selecting”; “counting means for **counting a number or reoccurrences of identical messages** being received” and “means for **measuring a frequency of messages to and from a**

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specific sender"; "a **second** check device"; "a **second** prioritizing device" and "a **second** device for selecting" are not adequately described in the specification in such a manner that they can be easily identified (emphasis added), therefore the Examiner is requesting that the Applicant **clearly** point out in the specification where support can be found or else the Applicant is required to modified the claim language and/or cancel claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-15, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 12 and 14; the claims 12 and 14 "counting means for counting a number or reoccurrences of identical messages being received" and "means for measuring a frequency of messages to and from a specific sender" use the phrase "means for" but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because for a computer-implemented means-plus function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to

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be more than simply a general purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor. However, there is no corresponding algorithm, **specifically**, disclosed in the specification. In light of specification (page 3, lines 28-35), it is unclear as to how the claimed means-plus functions are performed and what corresponding structures and/or algorithms are utilized to perform said claimed steps. As a result, the cited section of the specification does not seem to provide sufficient structure for performing claimed functions.

If Applicant wishes to have the claim limitation treated under U.S.C 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

10. If Applicant does **not** wishes to have the claim limitation treated under U.S.C 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a “means plus function limitation (e.g., deleting the phrase “means for”).

11. Regarding claims 1 and 17, claims 1 and 17 recite “first prioritizing means/device which assigns a priority to each of the first identification insignias of the senders of the first message” and “second prioritizing means/device which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages”. In view of fig. 1, where Applicant indicated the “first prioritizing means/device” is designated “5” and “second prioritizing means/device” is designated (15) (see, Applicant

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Arguments/Remarks Made in an Amendment, page 13), it is unclear how the first prioritizing means/device and the second prioritizing means/device are associated with the “first message” and “second message”, respectively, when in fig. 1, prior to (5) and (15), there is no indication that a second message is received being a reply to the returned message.

12. Claims 2-15 are dependent on claim 1 and Claim 18 is dependent on claim 17 and therefore inherit the 35 U.S.C. 112, second paragraph issues of the independent claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-4, 6-9, 11, and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) in view of Vincent J. Schiavone et al. (US Patent No. 20020120705 A1, referred herein after Schiavone).

As per claims 1, 16, Drummond discloses a filter / method for filtering electronic messages, said filter /method comprising:

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- **storage space** (fig. 2, "List of Approved Addresses, 212a") **for an allowed** (approved) **list** (list) **comprising identification insignias** (addresses) **of senders which have been approved** (approved) **for sending messages to a recipient** (col. 4, lines 38-67, fig. 2),
- **means** (e-mail server) **for receiving** (received) **a first** (first time) **message** (e-mail) **from a sender** (particular address) (col. 2, lines 25-36),
- **means** (e-mail server) **for capturing** (added) **from the first message** (e-mail) **a first identification insignia** (sending address) **of the sender** (col. 3, lines 1-5), ok
- **means** (e-mail server) **for capturing** (added) **from the message** (outbound e-mail) **a first identification insignia** (address) **of the recipient** (col. 2, lines 37-41),
- **first check means** (e-mail server) **for comparing** (determining) **the first identification insignia** (sending address) **of the sender with the allowed list** (list of approved addresses) **for determining either to withhold the first message** (holding queue) **or to forward** (released) **the first message to the recipient** (cols. 2-3, lines 57-67, lines 1-5),
- **means** (e-mail server) **for storing** (stores) **the first message and the first identification insignia of the sender** (col. 4, lines 38-67, fig. 2),
- **first means** **for selecting the first identification insignias and adding the selected identification insignias to the allowed list and delivering the first message to the intended recipients** (col. 5, lines 66-67 and col. 6, lines 1-25, fig. 3, where in fig. 3, for outbound mail 304, the recipient's address is saved in the list of approved addresses

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306 if sending address is on the list 310, the inbound mail 308 will be forwarded to the e-mail client 312),

- **means** (e-mail server) **for generating** (issued) **a return message** (email) **to the sender** (sending address) **in case the first identification insignia** (address) **of the sender is not** (not) **included in the allowed list** (list of approved addresses) (col. 2, lines 57-67),

- **the means** (e-mail server) **for returning the first message** (issuing an e-mail to the sending address) **being adapted to include in the returned message a unique code** (authorization code), **and a message for the sender to reply to the returned message by sending the returned message back without changing the unique code** (authorization code that must be included in any return acknowledgement) (col. 5, lines 7-33),

- **means** (e-mail server) **for storing** (stores) **the unique code and relating it to the insignia** (col. 4, lines 38-67, fig. 2; col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33; where authorization code (i.e. unique code) must be included in any return acknowledgement for the return to be considered authentic (i.e. “where sending address ...has been verified through a returned address and authorization code must be included in any return acknowledgement implies “unique code / insignia relationship”),

- **second check means** (e-mail server) **for receiving a second message and for recognizing the second message being a reply to the returned message** (cols. 2-3,

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lines 57-67, lines 1-5; where email is released from the holding queue upon receipt of the return acknowledgement),

wherein the filter further includes:

- second means for selecting identification insignias and adding the selected identification insignias to the allowed list (col. 6, lines 27-60, fig. 3, where in fig. 3, for return acknowledgement received 318, the e-mail's sending address is added to the list 326).

Drummond does not explicitly disclose **first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message; wherein the first means for selecting are adapted to carry out the selection according to the priorities assigned to the first identification insignias of the sending of the first messages; second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages; wherein the second means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias of the sending of the returned messages.**

However, Schiavone discloses **first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message; wherein the first means for selecting are adapted to carry out the selection**

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according to the priorities assigned to the first identification insignias of the sending of the first messages; second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages; wherein the second means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias of the sending of the returned messages (par. 0034, where incoming message is received by the network appliance (i.e. first or second prioritizing means) and priority information is assigned to messagepriority information is used to determine how and/or when to deliver the e-mail message; par. 0019 where mailers may be prioritized using source address; par. 0020, all e-mail from a given sender (i.e. email address) or domain (i.e. IP address) may be assigned a priority; par. 0017, where viewable portion of the message, e.g., body, subject line, etc. of the message may be used as the priority information; (i.e. priority information is used to determine how and/or when to deliver the e-mail message suggest first or second means for selecting)); pars. 0023, 0016 and 0017).). Since priority information can be assigned when incoming message are received by the network appliance and can be based source address, sender of email or domain, etc, it would have been an advantageous addition to Drummond to include this feature such that the priority information is assign to sender's or source address (i.e. identification insignias) for both the first and second messages since this information could be used to determine how and/or when to deliver the messages (also, see par. 0034)).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Schiavone's method of prioritizing the emails based on sender/source address and delivering the emails based on priority information assigned to address(es) to Drummond's method because this would reduce the burden on the recipient's network/system resources.

As per claim 2, claim 1 incorporated and Drummond discloses wherein the second check means performs the recognition by:

- capturing in the second message the unique code, and a second identification insignia of the sender of the second message, and checking that the unique code has not changed, and that the second identification insignia corresponds to the first identification insignia (col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33; where authorization code must be included in any return acknowledgement for the return to be considered authentic (i.e. this suggests that the return message must consist of the sender and recipient addresses that were in the first message along with the original authorization code (i.e. unique code) and this information (i.e. second identification insignia along with the unique code) must be verified (i.e. checking that the unique code has not changed, and that the second identification insignia corresponds to the first identification insignia) at the server, if the return acknowledgement is to be authentic).

As per claim 3, claim 1 incorporated and Drummond discloses further comprising means for capturing from a server a list comprising at least one address from which the sender has access to send messages from (col. 6, lines 10-26, fig. 3, “310”, “312”, where in fig. 3, if sending address is on the list (i.e. list of approved addresses) “310”, the email message is forwarded to e-mail client “312”).

As per claim 4, claim 3 incorporated and Drummond discloses further comprising means for checking that the sender is sending from an address included in the allowed list (col. 6, lines 10-26, fig. 3, “310”, “312”, where in fig. 3, if sending address is on the list (i.e. list of approved addresses) “310”, the email message is forwarded to e-mail client “312”).

As per claim 6, claim 1 incorporated and Drummond does not explicitly disclose further comprising rule based selection means which, based on recognition of a specific pattern in the content of the message sets the priority of the identification insignias.

However, Schiavone discloses **further comprising rule based selection means which, based on recognition of a specific pattern in the content of the message sets the priority of the identification insignias** (par. 0034, where incoming message is received by the network appliance and priority information is assigned to message.. ...priority information is used to determine how and/or when to deliver the e-mail

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message; par. 0019 where mailers may be prioritized using source address; par. 0020, all e-mail from a given sender (i.e. email address) or domain (i.e. IP address) may be assigned a priority; par. 0017, where viewable portion of the message, e.g., body, subject line, etc. of the message may be used as the priority information; par. 0026, messages may be determined to be spam using content-based analysis such as pattern matching, as is well known in the art; par. 0027, fig. 3, rule base 104 is referenced...rule base 104 stores recipient's, system, etc. preferences and rules for delivering e-mail messages).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Schiavone's method of determining and assigning the priority of received message based on priority information assigned to address(es) and delivery based on content-based analysis and referencing to rule-based information to Drummond's method because this would reduce the burden on the recipient's network/system resources.

As per claim 7, claim 1 incorporated and Drummond discloses further comprising means for automatically selecting identification insignias of the senders with priorities above a predetermined value for the allowed list (col. 7, lines 7-38, accept any email from sending address originating from the same domain as an approved address).

As per claim 8, claim 1 incorporated and Drummond discloses wherein the identification insignias of the senders and the data identifying the sender include

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at least a domain identification of the sender's electronic mail address (fig. 4, "e-mail clients, name@domain"; col. 7, lines 7-38, any email from sending address originating from the same domain).

As per claim 9, claim 1 incorporated and Drummond discloses further comprising means (e-mail server) for withholding the first message from final delivery to the intended recipient until an administrator (administrator) has accepted (accept) delivery of the message (e-mail) to the recipient, the administrator being one of a human administrator, a software-implemented administrator, and the recipient of the first message (col. 7, lines 30-38, a radio button 410 is checked if the system administrator desires to move the unsolicited e-mail to a lower delivery priority as opposed to deleting the email from a given holding queue (i.e. delaying or withholding message from delivery)).

As per claim 11, claim 1 incorporated and Drummond disclose comprising means for communicating, in an SMTP message (col. 3, line 44-45, fig. 1, SMTP-based client-server system), **and in response to receiving the first message from a sender with an insignia not included in the allowed list or optionally, with an insignia included in the black-list, that the first message could not be delivered to the recipient** (col. 6, lines 10- 26, fig. 3, "310", "314", a test is performed at step 310 determine whether a sending address of an inbound e-mail is on the list of approved

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addresses...test at step is negative...routine deems the e-mail to be unsolicited....place the unsolicited e-mail in the holding queue).

As per claim 14, claim 1 incorporated and Drummond discloses comprising means for measuring a frequency of messages to and from a specific sender and upon detection of frequencies above a pre-specified level, for forwarding the first message to the recipient irrespective if the first identification insignia of the sender is not in the allowed list (col. 7, lines 31-38; where frequency of unsolicited e-mail can be identified in order to determine an action (i.e. action could be to forward first message if detected frequencies is above a pre-specified level).

As per claim 15, claim 1 incorporated and Drummond discloses wherein the means for generating a return message to the sender is adapted to send the return message by use of an identification insignia corresponding to the identification insignia of the intended recipient of the first identification message (col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33; where authorization code must be included in any return acknowledgement for the return to be considered authentic (i.e. this suggests that the return message must consist of the sender address and recipient address that were originally in the first message (i.e. identification insignia corresponding to the identification insignia of the intended recipient of the first identification message) along

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with the unchanged authorization code and the information must be verified at the server, if the return acknowledgement is to be authentic).

As per claim 17, Drummond discloses a filter for filtering electronic messages, said filter comprising:

- **storage space** (fig. 2, "List of Approved Addresses, 212a") **for an allowed** (approved) **list** (list) **having identification insignias** (addresses) **of senders which have been approved** (approved) **for sending messages to a recipient** (col. 4, lines 38-67, fig. 2),
- **a device** (e-mail server) **for receiving** (received) **a first** (first time) **message** (e-mail) **from a sender** (particular address) (col. 2, lines 25-36),
- **a device** (e-mail server) **for capturing** (added) **from the first message** (e-mail) **a first identification insignia** (sending address) **of the sender** (col. 3, lines 1-5), ok
- **a device** (e-mail server) **for capturing** (added) **from the message** (outbound e-mail) **a first identification insignia** (address) **of the recipient** (col. 2, lines 37-41),
- **a first check device** (e-mail server) **for comparing** (determining) **the first identification insignia** (sending address) **of the sender with the allowed list** (list of approved addresses) **for determining either to withhold the first message** (holding queue) **or to forward** (released) **the first message to the recipient** (cols. 2-3, lines 57-67, lines 1-5),
- **a device for** (e-mail server) **for storing** (stores) **the first message and the first identification insignia of the sender** (col. 4, lines 38-67, fig. 2),

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- **a first device for selecting the first identification insignias and adding the selected identification insignias to the allowed list and delivering the first message to the intended recipients** (col. 5, lines 66-67 and col. 6, lines 1-25, fig. 3, where in fig. 3, for outbound mail 304, the recipient's address is saved in the list of approved addresses 306 if sending address is on the list 310, the inbound mail 308 will be forwarded to the e-mail client 312),
- **a device (e-mail server) for generating (issued) a return message (email) to the sender (sending address) in case the first identification insignia (address) of the sender is not (not) included in the allowed list (list of approved addresses)** (col. 2, lines 57-67),
- **the device (e-mail server) for returning the first message** (issuing an e-mail to the sending address) **being adapted to include in the returned message a unique code** (authorization code), **and a message for the sender to reply to the returned message by sending the returned message back without changing the unique code** (authorization code that must be included in any return acknowledgement) (col. 5, lines 7-33),
- **a device (e-mail server) for storing (stores) the unique code and relating the unique code to the first identification insignia of the sender** (col. 4, lines 38-67, fig. 2; col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33; where authorization code (i.e. unique code) must be included in any return acknowledgement for the return to be considered authentic (i.e. "where sending

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address ...has been verified through a returned address and authorization code must be included in any return acknowledgement implies “unique code / insignia relationship”),

- second check device (e-mail server) for receiving a second message and for recognizing the second message being a reply to the returned message (cols. 2-3, lines 57-67, lines 1-5; where email is released from the holding queue upon receipt of the return acknowledgement),

wherein the filter further includes:

- a second device for selecting identification insignias and adding the selected identification insignias to the allowed list (col. 6, lines 27-60, fig. 3, where in fig. 3, for return acknowledgement received 318, the e-mail's sending address is added to the list 326).

Drummond does not explicitly disclose **a first prioritizing device which assigns a priority to each of the first identification insignias of the senders of the first message; wherein the first device for selecting are adapted to carry out the selection according to the priorities assigned to the first identification insignias of the sending of the first messages; a second prioritizing device which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages; wherein the second device for selecting is adapted to**

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carry out the selection according to the priorities assigned to the identification insignias of the senders of the returned messages.

However, Schiavone discloses **a first prioritizing device which assigns a priority to each of the first identification insignias of the senders of the first message; wherein the first device for selecting are adapted to carry out the selection according to the priorities assigned to the first identification insignias of the sending of the first messages; a second prioritizing device which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages; wherein the second device for selecting is adapted to carry out the selection according to the priorities assigned to the identification insignias of the senders of the returned messages** (par. 0034, where incoming message is received by the network appliance (i.e. first or second prioritizing means) and priority information is assigned to messagepriority information is used to determine how and/or when to deliver the e-mail message; par. 0019 where mailers may be prioritized using source address; par. 0020, all e-mail from a given sender (i.e. email address) or domain (i.e. IP address) may be assigned a priority; par. 0017, where viewable portion of the message, e.g., body, subject line, etc. of the message may be used as the priority information; (i.e. priority information is used to determine how and/or when to deliver the e-mail message suggest first or second means for selecting)); pars. 0023, 0016 and 0017).). Since priority information can be assigned when incoming

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message are received by the network appliance and can be based source address, sender of email or domain, etc, it would have been an advantageous addition to Drummond to include this feature such that the priority information is assign to sender's or source address (i.e. identification insignias) for both the first and second messages since this information could be used to determine how and/or when to deliver the messages (also, see par. 0034)).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Schiavone's method of prioritizing the emails based on sender/source address and delivering the emails based on priority information assigned to address(es) to Drummond's method because this would reduce the burden on the recipient's network/system resources.

As per claim 18, claim 16 incorporated and Drummond discloses wherein the step of recognizing the second message being a reply to the returned message is further performed by: capturing in the second message the unique code, and a second identification insignia of the sender of the second message, and checking that the unique code has not changed, and that the second identification insignia corresponds to the first identification insignia (col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33;

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where authorization code must be included in any return acknowledgement for the return to be considered authentic (i.e. this suggests that the return message must consist of the sender and recipient addresses that were in the first message along with the original authorization code (i.e. unique code) and this information (i.e. second identification insignia along with the unique code) must be verified (i.e. checking that the unique code has not changed, and that the second identification insignia corresponds to the first identification insignia) at the server, if the return acknowledgement is to be authentic).

As per claim 19, claim 17 incorporated and Drummond discloses wherein the second check device performs the recognition by: capturing in the second message the unique code, and a second identification insignia of the sender of the second message, and checking that the unique code has not changed, and that the second identification insignia corresponds to the first identification insignia (col. 4, lines 58-67; where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement; col. 5, lines 7-33; where authorization code must be included in any return acknowledgement for the return to be considered authentic (i.e. this suggests that the return message must consist of the sender and recipient addresses that were in the first message along with the original authorization code (i.e. unique code) and this information (i.e. second identification insignia along with the unique code) must be verified (i.e. checking that the unique code has not changed, and that the second

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identification insignia corresponds to the first identification insignia) at the server, if the return acknowledgement is to be authentic).

15. Claims 5, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) and Vincent J. Schiavone et al. (US Patent No. 20020120705 A1, referred herein after Schiavone) in view of Roy Ben-Yoseph (US Patent No. 2004/0205127 A1, referred herein after Ben-Yoseph).

As per claim 5, claim 1 incorporated and Drummond and Schiavone do not specifically disclose further comprising means for generating a predict allowed list comprising identification insignias of third party message recipients included by the sender in the first message or the second message.

However, Ben-Yoseph discloses further comprising means for generating a predict allowed list comprising identification insignias of third party message recipients included by the sender in the first message or the second message (pg. 3, pars. 0043) where if a person B (sender) is designated as someone user A (recipient) knows, then the people (third parties) designed as known to person B also may be designated as known to user A (recipient).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of sender, thirty parties, and recipient associations to generate a predict allowed list to

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Drummond's and Schiavone's method because this would allow third party message recipients to be able to receive emails.

As per claim 10, claim 1 incorporated and Drummond and Schiavone do not specifically disclose further comprising storage for a blacklist, and means for checking occurrence of the identification insignias in the black-list prior to comparing the identification insignias with the allowed list.

However, Ben-Yoseph discloses further comprising storage for a blacklist, and means for checking occurrence of the identification insignias in the black-list prior to comparing the identification Insignias with the allowed list (pg. 4, par.

0055) where e-mail addresses are checked against blacklist in order to determine whether or not to they should be treated as spam and before the e-mail addresses are compared with the addresses on the allowed list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of checking the e-mail addresses against the blacklist first to Drummond's and Schiavone's method because this would eliminate the blacklisted email addresses first, thus reducing the number of emails required for comparison.

As per claim 13, claim 1 incorporated and Drummond and Schiavone do not specifically disclose comprising means for adding to the allowed list, insignias of potential senders to whom the recipient has previously been sending messages.

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However, Ben-Yoseph discloses comprising means for adding to the allowed list, insignias of potential senders to whom the recipient has previously been sending Messages (pg. 3, pars. 0042 & 0045) where communication identifiers may be inferred as known if a message from that communication identifier is read, replied to, forwarded, saved, or printed and where inferred identifiers are added to the list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of adding inferred identifiers to list to Drummond's and Schiavone's method because this would prevent e-mail addresses that are of interest to user but not on approved list to be received by the user and be added to the approved list.

16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) and Vincent J. Schiavone et al. (US Patent No. 20020120705 A1, referred herein after Schiavone) and Roy Ben-Yoseph (US Patent No. 2004/0205127 A1, referred herein after Ben-Yoseph) in view of William D. Cotten (US Patent No. 6330590 B1, referred herein after Cotten).

As per claim 12, claim 11 incorporated and Drummond, Schiavone and Ben-Yoseph do not specifically disclose comprising counting means for counting a number of reoccurrences of identical messages being received, and for adding

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the first insignia of the sender of such messages which reoccur more than a pre-specified number of times to the black-list.

However, Cotten discloses comprising counting means (server) for counting a number (three) of reoccurrences of identical (identical) messages (messages) being received (detected), and for adding the first insignia of the sender of such messages which reoccur more than a pre-specified number of times to the black-list (where such message are eliminated i.e. insignia added to blacklist) (abstract, col. 3, lines 47-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Cotten's method of eliminating identical messages that occur more than a pre-specified number of times to Drummond's, Schiavone's, and Ben-Yoseph's method because this would reduce the number of unsolicited e-mail messages received by the recipient.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form 892.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERMAN BELCHER whose telephone number is

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(571)270-7205. The examiner can normally be reached on Monday thru Thursday 7:30 AM thru 5:00 PM EST, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Herman A. Belcher

Examiner, Art Unit 2448

/Aaron Strange/
Primary Examiner, Art Unit 2448